

In the phone interview had with the Examiner, it was suggested to Applicant's attorney that if there was disagreement as to the propriety of the issuance of the Final Action, a request for reconsideration could be made. Accordingly, this request is hereby made based on the following arguments.

Claims 15-17, 24 and 25 are pending in the application and were rejected in the Final Action under 35 U.S.C. §103(a) as unpatentable over the newly cited Muller patent in view of the previously cited Lemchin patent, and with respect to Claim 25, additionally the Kesling '859 patent. In the previously issued Office Action dated July 27, 2007, rejections were made on the Collito, Chikami, Moschik, Johnston and Fujita references. Thus, rejections made in the above referred to Final Action were based on prior art not used in the previous Action and constitute new grounds of rejection.

Subsequent to the Action of July 27, 2007, an amendment was filed on October 19, 2007 responding to the Office Action and pursuant to an interview granted by Examiner Bumgarner. In that amendment, nominal amendments were made to the claims making them consistent with one another and more clearly defining the invention. Also, arguments were made distinguishing the claimed subject matter from the cited prior art, as well as pointing out that the references failed to teach various claim elements as asserted by the Examiner.

The justification asserted by the Examiner for the new grounds of rejection set forth in the Final Action is that the grounds were necessitated by the "Applicant's amendment." It is submitted that the amendments made to the claims are such that they did not necessitate a new ground of rejection, and therefore that the Final Action is premature.

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First, the Examiner asserts Muller discloses an orthodontic appliance including a metal appliance body and a light-permeable polymer resin bonding base, citing Column 2, line 55. This cited part of the application does not teach a light-permeable polymer resin base, although it is granted that such a teaching may be gleaned from lines 54 and 56 of Column 4. Nevertheless, while the limitation that the bonding base be light-permeable was added by amendment to Claims 24 and 25, it already existed in Claims 15-17.

The Examiner concedes that Muller does not teach a resin base that may be light, heat or chemically cured, and relies on Lemchin for such a teaching and asserts that it would be obvious because of Lemchin to cure the resin base of Muller by heat or light energy. In the event that the Final Action is withdrawn, Applicant reserves the right to contest this assertion. In any event, it would not be obvious to combine Lemchin with Muller because Muller was invented prior to the known usage of light-cured adhesive in the orthodontic industry.

The Examiner asserts that the appliance of Muller as modified by Lemchin is capable of "shipment to a user," apparently believing that the limitation of an appliance "for shipment to a user" added to Claims 24 and 25 is significant and necessitated this finding. Perhaps the Examiner overlooked that this limitation "for shipment to a user" was already in Claims 15-17, and it was merely put in Claims 24 and 25 for consistency purposes. In any event, there is absolutely no reference in Muller or Lemchin that the appliances disclosed were configured by a manufacturer for shipment to a user.

In view of the foregoing, it is submitted that the Final Action is premature, the new grounds of rejection were not necessitated by the amendment, and reconsideration of the issue

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and withdrawal of the Final Action to permit Applicant to submit arguments responding to the new rejections is respectfully submitted, and to also submit evidence of secondary considerations.

Respectfully submitted,



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